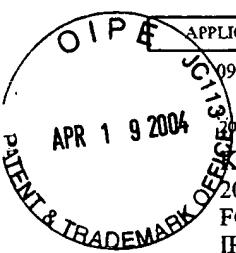


AUROBIO.026DV2 NSA



TRA/ETA
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,580	03/12/2001	Michael P. Maher	AUROBIO.026DV2	5039

SC113
10995 7590 05/21/2003

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER	
REDDING, DAVID A	
ART UNIT	PAPER NUMBER
1744	

DATE MAILED: 05/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

APR 19 2004

Office Action Summary

PATENT & TRADEMARK OFFICE	Application No.	Applicant(s)
	09/804,580	MAHER ET AL.
Examiner	Art Unit	
David A Redding	1744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 20 February 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-39 and 48-50 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-39 and 48-50 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 12 March 2001 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4

4) Interview Summary (PTO-413) Paper No(s) _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 1-39,48-50 in Paper No. 12 is acknowledged.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-39,48-50 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of copending Application No. 09/804,458 in view of USP 6,376,233 B1 (Wolf et al). The Wolf et al. patent discloses the measuring of fluorescence in combination with electronic measurements (col.3, lines 55-64). It would have been obvious to include the optical measurement means of the Wolf et al. patent in view of the known use of the measurement means with electrical measurement means.

This is a provisional obviousness-type double patenting rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A Redding whose telephone number is 703-308-3910. The examiner can normally be reached on M,T,Th,Fr, 7:30-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Warden can be reached on 703-308-2920. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



David A Redding
Primary Examiner
Art Unit 1744

D.A.R.
May 19, 2003



Notice of References Cited

APR 19 2004

		Application/Control No.	Applicant(s)/Patent Under Reexamination	
		09/804,580	MAHER ET AL.	
Examiner		Art Unit		Page 1 of 1
David A Redding		1744		

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
✓	A	US-6,376,233 B1	04-2002	Wolf et al.	435/288.4
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

PTO-1442
3 2001INFORMATION DISCLOSURE STATEMENT
BY APPLICANT
(USE SEVERAL SHEETS IF NECESSARY)U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICEATTY. DOCKET NO.
AUROBIO.026DV2APPLICATION NO.
09/804,580APPLICANT
Maher, et al.FILING DATE
March 21, 2001GROUP
1743

RECEIVED

AUG 14 2001

EXAMINER INITIAL	OTHER DOCUMENTS (INCLUDING AUTHOR, TITLE, DATE, PERTINENT PAGES, ETC.)	
TOR	48	Plonsey, Med & Biol. Eng. & Comput. 19 311-315 (1981).
DR	49	Plonsey, Med. & Biol. Eng. & Comput. 33 337-340 (1995).
DR	50	Plonsey and Barr, IEEE 42 329-336 (1995).
DR	51	Plonsey and Barr, IEEE 9/10 130-137 (1998.)
DR	52	Rattay, Neuroscience 89 335-346 (1999).
DR	53	Roth, Critical Reviews in Biomed. Eng. 22 263-305 (1994).
DR	54	Rowell, Biophotonics Int. 12 25-26 (2000).
DR	55	Schmidt et al., Proc. Natl. Acad. Sci. USA 94 8948-8953 (1997).
DR	56	Stone et al., J. Cardiovascular Electrophysiology 10 92-107 (1999).
DR	57	Svirskis et al., American Phys. Soc. 0022-3077 579-586 (1997).
DR	58	Tung and Borderies, Biophys. J. 63 371-386 (1992).
DR	59	Tung et al., Circulation Research 69 722-730 (1991).
DR	60	Zhou, et al., Circulation Research 83 1003-1014 (1998).

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EXAMINER	Paul Riedy	DATE CONSIDERED	4/11/03
*EXAMINER: INITIAL IF CITATION CONSIDERED, WHETHER OR NOT CITATION IS IN CONFORMANCE WITH MPEP 609; DRAW LINE THROUGH CITATION IF NOT IN CONFORMANCE AND NOT CONSIDERED. INCLUDE COPY OF THIS FORM WITH NEXT COMMUNICATION TO APPLICANT.			

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SHEET 2 OF 3

PTO-1449 13 2001	U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE	ATTY. DOCKET NO. AUROBIO.026DV2	APPLICATION NO. 09/804,580
INFORMATION DISCLOSURE STATEMENT BY APPLICANT		APPLICANT Maher, et al.	
(USE SEVERAL SHEETS IF NECESSARY)		FILING DATE March 21, 2001	GROUP 1743

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TC 1700

U.S. PATENT DOCUMENTS							
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE (IF APPROPRIATE)
DAR	27	6,046,002	4/4/00	Davis, et al.	435	6	
DAR	28	6,051,422	4/18/00	Kovacs, et al.	435	287.1	
DAR	29	6,063,260	5/16/00	Olesen, et al.	205	793	
DAR	30	6,099,960	8/8/00	Tennent, et al.	438	367	
DAR	31	6,205,016	3/20/01	Niu	361	503	

FOREIGN PATENT DOCUMENTS							
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION
							YES NO
DAR	32	WO97/05922	2/20/97	PCT	—	—	
DAR	33	WO00/25121	5/4/00	PCT	—	—	
DAR	34	WO00/68686	11/16/00	PCT	—	—	
DAR	35	1 067 378 A1	1/10/01	EPO	—	—	

EXAMINER INITIAL	OTHER DOCUMENTS (INCLUDING AUTHOR, TITLE, DATE, PERTINENT PAGES, ETC.)	
DAR	36	Arndts, Oral Presentation Abstract, Second International Cell Analysis Products Users Meeting in Hilton Head Island, South Carolina, USA (June 3-5, 1998).
DAR	37	Barr and Plonsey, Biophys. J. 61, 1164-1175 (1992).
DAR	38	Barr and Plonsey, IEEE 42, 1185-11911 (1995).
DAR	39	Cartee and Plonsey, Med & Biol. Eng. & Comp. 30 389-398 (1992).
DAR	40	Cartee and Plonsey, IEEE 39, 76-85 (1992).
DAR	41	Eppich et al., Nature Biotech. 18, 882-887 (2000).
DAR	42	Greenberg, et al. IEEE 46, 505-514 (1999).
DAR	43	Gross, et al. Biophys. J. 50, 339-348 (1986).
DAR	44	Jentsch and Günther, BioEssays 19, 117-126 (1997).
DAR	45	Klee and Plonsey, Biophys. J. 12 1661-1675 (1972).
DAR	46	Klee and Plonsey, IEEE 23, 347-354 (1976).
DAR	47	Mitchell et al., J. Biomed. Eng. 14, 52-56 (1992).

EXAMINER	<i>Dar</i>	DATE CONSIDERED	<i>4/1/03</i>
*EXAMINER: INITIAL IF CITATION CONSIDERED, WHETHER OR NOT CITATION IS IN CONFORMANCE WITH MPEP 609; DRAW LINE THROUGH CITATION IF NOT IN CONFORMANCE AND NOT CONSIDERED, INCLUDE COPY OF THIS FORM WITH NEXT COMMUNICATION TO APPLICANT.			

1743
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SHEET 1 OF 3

AM PTO-146 13 2001	U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE	ATTY. DOCKET NO. AUROBIO.026DV2	APPLICATION NO. 09/804,580
INFORMATION DISCLOSURE STATEMENT BY APPLICANT		APPLICANT Maher, et al.	RECEIVED AUG 14 2001 TC 1700
(USE SEVERAL SHEETS IF NECESSARY)		FILING DATE March 21, 2001	

U.S. PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE (IF APPROPRIATE)
DAM	4,072,578	2/7/78	Cady, et al.	195	127	
YMG	4,514,500	4/30/85	Giaeever, et al.	435	241	
DKR	4,461,304	7/24/84	Kuperstein	128	642	
EDR	4,628,933	12/16/86	Michelson	128	41912	
DRR	4,677,989	7/7/87	Robblee	128	784	
TKR	4,969,468	11/13/90	Byers, et al.	128	642	
DRR	5,024,233	6/18/91	Chow	128	41912	
DKR	5,178,161	1/12/93	Kovacs	128	784	
DKR	5,187,096	2/16/93	Giaeever, et al.	435	291	
DKR	5,405,367	4/11/95	Schulman, et al.	607	61	
DKR	5,432,086	7/11/95	Fränzl, et al.	435	291	
DKR	5,439,440	8/8/95	Hofmann	604	30	
DKR	5,545,130	8/13/96	Hofmann, et al.	604	4	
DKR	5,563,067	10/8/96	Sugihara, et al.	435	287.1	
DKR	5,571,158	11/5/96	Bolz, et al.	607	121	
DKR	5,810,725	9/22/98	Sugihara, et al.	600	372	
DKR	5,855,801	1/5/99	Lin, et al.	216	2	
DKR	5,935,155	8/10/99	Humayun, et al.	607	54	
DKR	5,957,958	9/28/99	Schulman, et al.	607	56	
DKR	5,965,452	10/12/99	Kovacs	436	149	
DKR	5,981,268	11/9/99	Kovacs, et al.	435	287.1	
KTR	6,008,038	12/28/99	Kröger, et al.	435	285.2	
DKR	6,009,347	12/28/99	Hofmann	604	21	
DKR	6,024,702	2/15/00	Iversen	600	378	
DKR	6,031,711	2/29/00	Tennent, et al.	361	303	
DKR	6,038,478	3/14/00	Yuen, et al.	607	74	

EXAMINER David Ridley	DATE CONSIDERED 4/11/03
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U. S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

ATTY. DOCKET NO.
AUROBIO.026DV2

APPLICATION NO.
09/804,580

**SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT
BY APPLICANT**

(USE SEVERAL SHEETS IF NECESSARY)

APPLICANT
Maher, et al.

FILING DATE
March 12, 2001

GROUP
1743

U.S. PATENT DOCUMENTS

FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL	OTHER DOCUMENTS (INCLUDING AUTHOR, TITLE, DATE, PERTINENT PAGES, ETC.)
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JGD	3. González, J.E., et al., "Voltage sensing by fluorescence resonance energy transfer in single cells", Biophysical Journal, Vol. 69, No. 4, pp. 1272-1280, (October 1995).
JGD	4. Giuliano, K.A., et al., "Fluorescent-protein biosensors: new tools for drug discovery", Trends In Biotechnology", Vol. 16, No. 3, pp. 135-140, (March 1998).

EXAMINER <i>Dan Rudey</i>	DATE CONSIDERED <i>4/11/03</i>
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